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Fish & Associates  
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In re Application of :  
Ke *et al* :  
U.S. Application No.: 10/596,306 :  
PCT No.: PCT/US2004/043499 :  
Int. Filing Date: 22 December 2004 :  
Priority Date: 23 December 2003 :  
Docket No.: 100788.0023US :  
For: Multiplexed Nucleic Acid :  
Analysis With High Specificity :

**DECISION**

This decision is in response to the "Request For Withdrawal..." filed on 06 August 2008 and the "Revocation of Power of Attorney..." filed on 19 November 2008.

**DISCUSSION**

37 CFR 1.36(a) states that a power of attorney may be revoked at any stage in the proceedings of a case by an applicant or assignee. Section 402.05 of the Manual of Patent Examining Procedure (MPEP) discusses revocation and states:

Revocation of the power of attorney becomes effective on the date that the revocation is RECEIVED in the Office (not on the date of ACCEPTANCE).

Here, the request for revocation of all previous powers of attorney and grant of power of attorney to the attorneys and/or patent agents associated with customer number 24392 was signed on behalf of the putative assignee of the subject application by Fareed Kureshy in the capacity of "CEO." Attached thereto is a "Statement Under 37 CFR 3.73(b)" signed by Mr. Kureshy and indicating that Autogenomics, Inc. is the assignee of the entire right, title and interest. The 37 CFR 3.73(b) statement refers to a chain of title from joint inventor Ke to the assignee, but does not similarly and explicitly indicate that the other joint inventors have also conveyed title to Autogenomics. It is also stated that documentary evidence of the chain of title was being submitted for recordation purposes, but no such assignment appears to have been recorded. For these reasons, the statement under 37 CFR 3.73(b) is defective. Accordingly, it

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would not be appropriate to accept the request for revocation on the basis of the present record.

Concerning the request for withdrawal, 37 CFR 1.36(b) states in part that

A registered patent attorney or patent agent who has been given a power of attorney pursuant to §1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply.

Counsel states that

The reasons for this request are: Attorney and agents left this customer number 3/3/2007. It was agreed that attorney or his agents would file new powers of attorney for requested client transfers. Attorney has not filed a new power of attorney or has not changed their correspondence address. Therefore, we request withdrawal as power of attorney, and that the correspondence address be changed.

Thus, the reason for the requested withdrawal appears to be an agreement with other counsel (Fish) as to who will represent the client. However, it is not clear which, or whether all, of the owner(s) of the application consent to the change in representation (since the 37 CFR 3.73(b) statement proffered by Fish does not adequately account for all of the inventors' rights). Moreover, counsel's reason does not appear to fall within one of the reasons listed in 37 CFR 10.40. For these reasons, it would not be appropriate to accept either the "Request For Withdrawal..." or the "Revocation of Power of Attorney..." at this time.

As explained at MPEP 403, prior to filing an executed oath or declaration of inventorship,

the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that

application under this paragraph.

Accordingly, the correspondence address is being changed to the address for Fish & Associates provided in the "Request For Withdrawal" filed on 06 August 2008.

**DECISION**

The requests are **DISMISSED**, without prejudice.

This application will be returned to Technology Center 1634 for further processing. The correspondence address is being changed to the Fish & Associates address appearing above.

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